Hovsepian v. Apple, Inc.

Doc. 60 Att. 8

EXHIBIT 8

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Yurt *et al.* Appl. No. 09/120,452 Filed: July 23, 1998 For: **Audio and Video Transmission and Receiving System**	Art Unit: 2712 Examiner: A. Le Atty. Docket: 03047.0006.US04

~~Second~~ Preliminary Amendment

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Please enter the following Second Preliminary Amendment in the above-captioned application prior to the examination thereof.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 08-3038.

02/16/1999 TLUU11 00000063 09120452
01 FC:103 126.00 OP

Amendments

In the Claims:

Please cancel claims 1-9 and 12-20 currently pending in the application without prejudice to or disclaimer of the subject matter contained therein. Please substitute therefor the following new claims 33-59.

--33. A communication system comprising:

a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises

an identification encoder, and

a compressed data library in data communication with said identification encoder; and

wherein said reception system comprises

a transceiver in data communication with said transmission system,

a storage device in data communication with said transceiver,

user playback controls in data communication with said storage device,

a digital decompressor in data communication with said storage device, and

a playback device in data communication with said digital decompressor.

34. A communication system as recited in Claim 33, wherein said transmission system further comprises:

a source material library storing a portion of at least one data file.

35. A communication system as recited in Claim 34, wherein said transmission system further comprises:

a converter having a data input in data communication with said source material library and a digital data output.

a1 cont.

4 ~~36~~. A communication system as recited in Claim 3 ~~35~~, wherein said transmission system further comprises:

a data compressor in data communication with said digital data output of said converter.

5 ~~37~~. A communication system as recited in Claim 1 ~~33~~, wherein said transmission system further comprises:

a compressed data formatting device in data communication with said identification encoder.

6 ~~38~~. A communication system as recited in Claim 1 ~~33~~, wherein said identification encoder allows entry of a popularity code.

~~39. A communication system as recited in Claim 33, wherein said transmission system further comprises a sequence encoder.~~

7 ~~40~~. A communication system as recited in Claim 1 ~~39~~, wherein said sequence encoder transforms digital data blocks into a group of addressable data blocks.

8 ~~41~~. A communication system as recited in Claim 1 ~~33~~, wherein said transmission system further comprises:

a transmitter in data communication with said compressed data library, wherein said transmitter sends at least a portion of a compressed data file to said reception system.

9 ~~42~~. A communication system as recited in Claim 1 ~~33~~, further comprising:

a user request interface in data communication with said transmission system, wherein said user request interface enables a user to make a request for at least a portion of a data file.

10 ~~43~~. A communication system as recited in Claim 9 ~~42~~, wherein said reception system comprises said user request interface.

a1 cont.

11 ~~44~~. A communication system as recited in Claim 1 ~~33~~, wherein said reception system further comprises:

a receiver format converter in data communication with said transceiver, wherein said receiver format converter converts at least a portion of a data file into a format suitable for playback by a user.

12 ~~45~~. A communication system as recited in Claim 1 ~~33~~, wherein said reception system further comprises:

an output data converter in data communication with said digital decompressor.

13 ~~46~~. A communication system as recited in Claim 1 ~~33~~, wherein said storage device stores at least a portion of a data file.

15 ~~47~~. A communication system as recited in Claim 1 ~~33~~, wherein said storage device stores an entire data file.

14 ~~48~~. A communication system as recited in Claim 13 ~~46~~, wherein said storage device is a temporary storage device.

16 ~~49~~. A communication system as recited in Claim 15 ~~47~~, wherein said storage device is a temporary storage device.

17 ~~50~~. A communication system comprising:

a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises

a source material library,

an identification encoder in data communication with said source material library,

a converter having a data input in data communication with said source material library and a digital data output,

a sequence encoder in data communication with said digital data output,

a digital data compressor in data communication with said digital data

a1 cont.

output,

a compressed data formatting device in data communication with said digital data compressor,

a compressed data library in data communication with said compressed data formatting device, and

a transmitter in data communication with said compressed data library; and wherein said reception system comprises

a transceiver in data communication with said transmission system,

a receiver format converter in data communication with said transceiver,

a storage device in data communication with said receiver format converter,

user playback controls in data communication with said storage device,

a digital decompressor in data communication with said receiver format converter, and

an output data converter in data communication with said digital decompressor.

18 ~~51.~~ A communication system as recited in Claim ~~50,~~ 17 wherein said digital data compressor is in data communication with said sequence encoder.

19 ~~52.~~ A communication system as recited in Claim ~~50,~~ 17 wherein said compressed data formatting device is in data communication with said identification encoder.

20 ~~53.~~ A communication system as recited in Claim ~~50,~~ 17 further comprising:

a user request interface in data communication with said transmission system.

21 ~~54.~~ A communication system as recited in Claim ~~53,~~ 20 wherein said reception system comprises said user request interface.

22 ~~55.~~ A communication system as recited in Claim ~~50,~~ 17 wherein said storage device stores at least a portion of a data file.

a1 end

23 ~~56~~. A communication system as recited in Claim ~~50~~ 17, wherein said storage device stores an entire data file.

24 ~~57~~. A communication system as recited in Claim ~~50~~ 17, wherein said transceiver transmits a user request for a data file to said transmission system and receives the entire data file as compressed data blocks from said transmission system.

25 ~~58~~. A communication system as recited in Claim ~~50~~ 17, wherein said transceiver transmits a user request for at least a portion of a data file to said transmission system and receives the portion of the data file as compressed data blocks from said transmission system.

26 ~~59~~. A communication system as recited in Claim ~~50~~ 17, wherein said output data converter is in data communication with said storage device. --

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Remarks

Upon entry of the foregoing amendment, claims 33-59 are pending for the Examiner's consideration, with claims 33 and 50 being the independent claims. Claims 1-9 and 12-20 have been canceled herein without prejudice to or disclaimer of the subject matter contained therein. Claims 10-11 and 21-32 were previously canceled without prejudice to or disclaimer of the subject matter contained therein. New claims 33-59 have been added. These changes are believed to introduce no new matter, and their entry is respectfully requested. In this regard, the Examiner is referred to, for example, figures 2a, 2b, and 6, and page 12, line 14 through page 29, line 13 and page 38, line 24 through page 40, line 9, of the application as originally filed.

Conclusion

Prompt and favorable consideration of this Second Preliminary Amendment is respectfully requested.

Respectfully submitted,

Andrea G. Reister
Registration No. 36,253

Date: February 10, 1999

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Washington, D.C. 20231

ml 8

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/120,452	07/23/98	YURT	P 02473.0004

LM12/0625

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EXAMINER	
LE, A	
ART UNIT	PAPER NUMBER
2734	8

DATE MAILED: 06/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

1- File Copy

Office Action Summary	Application No. 09/120,452	Applicant(s) Paul Yurt et al
	Examiner Amanda T. Le	Group Art Unit 2734

☒ Responsive to communication(s) filed on 2/10/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 33-59 is/are pending in the application.

Of the above, claim(s) ______ is/are withdrawn from consideration.

☐ Claim(s) ______ is/are allowed.

☒ Claim(s) 33-37 and 39-59 is/are rejected.

☒ Claim(s) 38 is/are objected to.

☐ Claims ______ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on ______ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on ______ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) ______.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

1. Claims 33-59 are pending in this application. This Office Action supersedes the Office Action mailed on 03/05/99 which did not take into consideration of the Preliminary Amendment filed on 2/10/99.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970):and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 33-37, 39-59 are rejected under the judicially created doctrine of double patenting over claims 1-27 of U. S. Patent No. 5,132,992 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matters.

Furthermore, there is no apparent reason why applicants were prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 33-37, 41-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Tindell et al (submitted by Applicants, U.S. Patent no. 5,130,792).

Tindell et al's store and forward video system (Fig. 2, 3, 5-7) teaches the following claimed subject matters: "identification encoder" (46, or col 3, lines 25-27); "compressed data library" (22); "transceiver" (col. 2, line 60-col. 3, line 3); "storage device" (76, 78); "user playback control" (72); "digital decompressor" (82); "playback device" (88, 126, col 5, lines 55-58); "source material library" (24); "converter" (26); "compressor" (44); "format converter" (32, 33); "user request interface" (80, col. 2, line 60-col. 3, line 3); "output converter" (86, 88); "transmitter" (108).

Allowable Subject Matter

6. Claims 39 and 40 would be allowable if rewritten to overcome the double patenting rejection, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Claims 50-59 would be allowable if rewritten or amended to overcome the double patenting rejection set forth in this Office action.

8. Claims 38 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6743, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Le, whose telephone number is (703) 305-4769. The Examiner can normally be reached on Tuesday-Friday from 8:00 A.M. - 5:30 P.M. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703)305-4714

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

June 22, 1999

Amanda Le

Amanda T. Le
Primary Patent Examiner

#9/B
8/11/99

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Group 2700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OIPE JC73 AUG 0 6 1999 PATENT & TRADEMARK OFFICE

In re application of:	Art Unit: 2734
Paul YURT *et al.*	Examiner: Le, A.
Appln. No.: 09/120,452	Atty. Docket: 03047.0006.US04
Filed: July 23, 1998	
For: Audio and Video Transmission and Receiving System	

Reply and Amendment Under 37 C.F.R. § 1.111

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

In response to the Office Action dated June 25, 1999, (PTO Prosecution File Wrapper Paper No. 8), Applicants submit the following Amendment and Remarks.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 08-3038.

Amendments

In the Claims:

Please amend claim 33 as follows:

33. (Amended) A communication system comprising:

a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises

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~~an identification encoder, and~~

a compressed data library in data communication with ~~said identification~~ encoder, wherein said identification encoder gives items in said compressed data library a unique identification code; and

wherein said reception system comprises

a transceiver in data communication with said transmission system,

a storage device in data communication with said transceiver,

user playback controls in data communication with said storage device,

a digital decompressor in data communication with said storage device, and

~~a playback device in data communication with said digital decompressor.~~

Please add the following new claims:

27 --~~60~~. A communication system comprising:

a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises

an identification encoder, wherein said identification encoder allows entry of a popularity code; and

a compressed data library in data communication with said identification encoder; and

wherein said reception system comprises

a transceiver in data communication with said transmission system,

a storage device in data communication with said transceiver,

user playback controls in data communication with said storage device,

a digital decompressor in data communication with said storage device, and

a playback device in data communication with said digital decompressor.

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28 ~~61~~. A communication system as recited in claim ~~60~~ 27, wherein said transmission system further comprises:

a source material library storing a portion of at least one data file.

29 ~~62~~. A communication system as recited in claim ~~61~~ 28, wherein said transmission system further comprises:

a converter having a data input in data communication with said source material library and a digital data output.

30 ~~63~~. A communication system as recited in claim ~~62~~ 29, wherein said transmission system further comprises:

a data compressor in data communication with said digital data output of said converter.

31 ~~64~~. A communication system as recited in claim ~~60~~ 27, wherein said transmission system further comprises:

a compressed data formatting device in data communication with said identification encoder.

32 ~~65~~. A communication system as recited in claim ~~60~~ 27, wherein said transmission system further comprises a sequence encoder.

33 ~~66~~. A communication system as recited in claim ~~65~~ 32, wherein said sequence encoder transforms digital data blocks into a group of addressable data blocks.

34 ~~67~~. A communication system as recited in claim ~~60~~ 27, wherein said transmission system further comprises:

a transmitter in data communication with said compressed data library, wherein said transmitter sends at least a portion of a compressed data file to said reception system.

~~68~~ 35. A communication system as recited in claim ~~60~~ 27, further comprising:

a user request interface in data communication with said transmission system, wherein said user request interface enables a user to make a request for at least a portion of a data file.

~~69~~ 36. A communication system as recited in claim ~~68~~ 35, wherein said reception system comprises said user request interface.

~~70~~ 37. A communication system as recited in claim ~~60~~ 27, wherein said reception system further comprises:

a receiver format converter in data communication with said transceiver, wherein said receiver format converter converts at least a portion of a data file into a format suitable for playback by a user.

B3

~~71~~ 38. A communication system as recited in claim ~~60~~ 27, wherein said reception system further comprises:

an output data converter in data communication with said digital decompressor.

~~72~~ 39. A communication system as recited in claim ~~60~~ 27, wherein said storage device stores at least a portion of a data file.

~~73~~ 40. A communication system as recited in Claim ~~60~~ 27, wherein said storage device stores an entire data file.

52

~~74~~ 41. A communication system as recited in Claim ~~72~~ 39, wherein said storage device is a temporary storage device.

~~75~~ 42. A communication system as recited in Claim ~~73~~ 40, wherein said storage device is a temporary storage device.--

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Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 33-75 are pending in the application, with 33, 50 and 60 being the independent claims. New claims 60-75 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following Remarks, Applicants respectfully request that the examiner reconsider all outstanding objections and rejections and they be withdrawn.

Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 33-37 and 41-49 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,130,792 to Tindell *et al.* ("the Tindell patent,"). Applicants believe the Examiner has misinterpreted the claim element of "identification encoder." In the application, the "identification encoder" is in data communication with a compressed data library and the identification encoder gives items in the compressed data library a unique identification code." *See* application page 22, ll. 3-14. The Examiner suggests that encoder 46 of the Tindell

53

patent teaches such a function. *See* Office Action ¶ 5, line 4. However, encoder 46 functions to encrypt data and not to give a unique identification code. *See* the Tindell patent, col. 3, ll. 25-27. Applicants have amended claim 33 to more clearly define the function of the identification encoder of the present invention. Because of their dependence on independent claim 33, claims 34-38 and 41-49 are also allowable.

Moreover, with respect to claim 44, the receiver format converter is in data communication with a transceiver *in the reception system*. Such an element is not shown or disclosed in the Tindell patent. The Examiner suggests that elements 32 and 33 [*sic*] of the Tindell patent are analogous to Applicants' claimed format converter. *See* Office Action ¶ 5, line 7. The Tindell patent discloses elements 32 and 34 as being located in the Central Data Facility 10, and not in the reception system as claimed by the Applicants.

Other Matters

The Examiner has rejected claims 33-37 and 39-59 under the doctrine of obviousness-type double patenting over claims 1-27 of U.S. Patent No. 5,132,992. Applicants submit herewith a Terminal Disclaimer to Obviate a Double Patenting Rejection under 37 C.F.R. § 1.321(c). The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991) (the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor an estoppel on the merits of the rejection); M.P.E.P. § 804.02.

Applicants note with appreciation the Examiner's indication of allowable subject matter in claim 38. Accordingly, Applicants have added new claim 60 that incorporates the elements of original claims 33 and 38. Applicants have also added claims 61-74 that depend from new claim 60 and include the elements of claims 34-37 and 39-49. Because of their dependence on allowable claim 60, these claims are also allowable.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

Andrea G. Reister

Andrea G. Reister (Reg. No. 36,253)

Date: August 6, 1999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/120,452	07/23/98	YURT P	02473.0004

LM01/1026

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EXAMINER	
LE, A	
ART UNIT	PAPER NUMBER
2734	12

DATE MAILED: 10/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

Exhibit 8 Page 172

1- File Copy

Office Action Summary	Application No. 09/120,452	Applicant(s) Paul Yurt et al
	Examiner Amanda T. Le	Group Art Unit 2734

☒ Responsive to communication(s) filed on 8/6/99.

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 33-75 is/are pending in the application.

Of the above, claim(s) ______ is/are withdrawn from consideration.

☐ Claim(s) ______ is/are allowed.

☒ Claim(s) 33-75 is/are rejected.

☐ Claim(s) ______ is/are objected to.

☐ Claims ______ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on ______ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on ______ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) ______.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

1. This Office Action is responsive to the amendment filed on 08/06/99 and it is made non-final. Claims 33-75 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 33-37, 41-49 have been considered but are moot in view of the new ground(s) of rejection.

3. The indicated allowability of claims 38-40, 50-59 is withdrawn in view of the newly discovered reference(s) to DeBey. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 33-75 are rejected under 35 U.S.C. 102(e) as being anticipated by DeBey.

Regarding claims 33, 38-40, 60, 65-57 DeBey's system for transmissions of programs to multiple users teaches the following claimed subject matters: "compressed data library" (fig. 1, elements 12, 14, 16, 18), "identification encoder" and "sequence encoder" (Fig. 1, elements 12, 20, col. 7, lines 55-61), "transceiver" (Fig. 2, modem 48, col. 7, lines 1-4), "storage device" (Fig. 2, memory 42, col. 6, lines 45-47), "user playback control" (Fig. 2, controller 52, col. 6, lines 65-67), "digital decompressor" (fig. 2, element 50, col. 6, lines 64-65), "playback device" (Fig. 2, element 44).

Regarding claims 34-36, 61-63, DeBey's disclosure (col. 4, lines 22-27) and media compression system (Fig. 1, element 10) inherently teaches the claimed "source material library," "converter" and "compressor."

Regarding claims 37, 64, DeBey further discloses the claimed "formatting device" (col. 4, lines 52-66).

Regarding claims 41, 68, DeBey further discloses the claimed "transmitter" (Fig. 1, 2, element 24).

Regarding claims 42, 43, 69, DeBey further discloses the claimed "user request interface" (Fig. 2, element 54, col. 7, lines 1-4).

Regarding claim 44, 70, DeBey further teaches the claimed "receiver format converter" (col. 6, lines 50-62).

Regarding claim 45, 71, DeBey further inherently teaches the claimed "output converter" (col. 5, lines 35-43).

Regarding claims 46-49, 72-25, DeBey further teaches the claimed "storage device" (buffer memory 42, col. 11, lines 24-44).

Similar to claims 33-49 above, all the limitations of claims 50-59 are disclosed in the DeBey reference.

Conclusion

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6743, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Le, whose telephone number is (703) 305-4769. The Examiner can normally be reached on Tuesday-Friday from 8:00 A.M. - 5:30 P.M. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703)305-4714.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

Amanda Le

October 22, 1999

Amanda T. Le
Primary Patent Examiner

#13 Req. for Reconsideration 11/16/99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

YURT *et al.*

Appl. No. 09/120,452

Filed: July 23, 1998

For: Audio and Video Transmission and Receiving System

OIPE JC80 NOV 12 1999 PATENT & TRADEMARK OFFICE

Art Unit: 2734

Examiner: Le, A.

Atty. Docket: 03047.0006.US04

RECEIVED NOV 15 1999 TECH CENTER 2700

Reply Under 37 C.F.R. § 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated October 26, 1999 (PTO Prosecution File Wrapper Paper No. 12), Applicants submit the following Remarks.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 08-3038.

Remarks

Reconsideration of this Application is respectfully requested.

Claims 33-75 are currently pending in the application, with 33, 50 and 60 being the independent claims. Based on the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and they be withdrawn.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 33-75 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,701,582 to DeBey ("the DeBey patent"). Applicants maintain that the rejection based upon the DeBey patent is improper under 35 U.S.C. § 102(e).

The effective filling date for the pending claims is January 7, 1991. Under 35 U.S.C. § 102(e) an issued patent that was filed in the United States prior to the invention by Applicants of the claimed subject matter may be relied upon to show anticipation. The DeBey patent issued from U.S. Application Serial No. 408,440 filed March 22, 1995, which is subsequent to the effective filing date of Applicants' claims. However, the DeBey patent claims priority as a continuation-in-part (CIP) of Ser. No. 173,865 filed December 23, 1993, which is a continuation of Ser. No. 835,947 filed as PCT/AU90/00370 on August 23, 1990, now abandoned. The earliest filing date of August 23, 1990 is apparently relied upon by the Examiner in the Office Action because all other dates in the chain of priority are subsequent to Applicants' effective filing date.

A proper rejection under 35 U.S.C. § 102(e) has not been established for at least the reason that there is no showing in the Office Action that any application in the priority chain filed prior to January 7, 1991 supports the claims of the DeBey patent. "In order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must . . . support the invention as required by 35 U.S.C. § 112, first paragraph." MPEP § 2136.03 (citing *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA

1981)). Even if Ser. No. 835,947 could properly be accorded a filing date of August 23, 1990 for purposes of §102(e) (a premise Applicants dispute as discussed below), there is no showing in the Office Action that Ser. No. 835,947 supports the claims in the DeBey patent. For at least these reasons, a proper rejection under 35 U.S.C. § 102(e) has not, therefore, been established in the Office Action.

Moreover, it has not been demonstrated in the Office Action that the disclosure of the parent application Ser. No. 835,947 includes the subject matter that is applied against the present application to negate patentability under 35 U.S.C. § 102(e). "[W]hen the reference is a continuation-in-part of an earlier filed application . . . and it is necessary to go back to the earlier filing date, the fact that the subject matter relied upon was originally disclosed on that date in the first application should be stated." MPEP § 707.05(e). Applicants submit that since the chain of applications relied upon includes a continuation-in-part application, the disclosure of the issued patent may not be applied under 35 U.S.C. § 102(e) without demonstrating that the subject matter relied upon was disclosed in the application that was filed prior to the effective filing date of Applicants' claims. There is no such support provided. The rejection in the Office Action under 35 U.S.C. § 102(e) includes no demonstration that the subject matter relied upon was disclosed in any application filed prior to January 7, 1991. For this reason as well, a proper rejection under 35 U.S.C. § 102(e) has not been established.

Applicants respectfully submit that the effective filing date for Ser. No. 835,947 is April 2, 1992, after Applicants' priority date of January 7, 1991. Support for this position is contained in U.S. Patent No. 5,421,031 (copy enclosed), which issued as a continuation application of Ser. No. 835,947. Under Related U.S. Application Data on U.S. Patent No. 5,421,031, the U.S. filing date of Ser. No. 835,947 is listed as April 2, 1992.

For at least the foregoing reasons, Applicants respectfully submit that neither U.S. Patent No. 5,701,582 cited by the examiner, nor U.S. Patent No. 5,421,031 qualify as prior art under 35 U.S.C. § 102(e) against the above-captioned application.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

Andrea G. Reister

Andrea G. Reister (Reg. No. 36,253)

Date: November 12, 1999

HOWREY & SIMON
Box No. 34
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2402
(202) 783-0800

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ML

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/120,452	07/23/98	YURT	P 02473.0004

LM01/0124

HOWREY & SIMON
BOX NO. 34
1299 PENNSYLVANIA AVENUE, NW
WASHINGTON DC 20004-2402

EXAMINER	
LE, A	
ART UNIT	PAPER NUMBER
2734	14

DATE MAILED: 01/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Exhibit 8 Page 181

Office Action Summary	Application No. 09/120,452	Applicant(s) Paul Yurt et al
	Examiner Amanda T. Le	Group Art Unit 2734

☒ Responsive to communication(s) filed on *Nov 12, 1999*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *33-75* is/are pending in the application.

Of the above, claim(s) ______ is/are withdrawn from consideration.

☒ Claim(s) *50-75.* is/are allowed.

☒ Claim(s) *33-37 and 41-49* is/are rejected.

☒ Claim(s) *38-40* is/are objected to.

☐ Claims ______ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on ______ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on ______ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) ______.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). ______

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

1. This Office Action is responsive to the communication filed on 11/12/99. Claims 33-75 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 33-37, 41-49 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 33-37, 41-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter (4,506,387, PTO-1449 filed on 02/10/99).

Walter (Fig. 1) discloses the following claimed limitations: "transmission system" (12), "reception system" (14), "compressed data library" (24-34, col. 2, lines 17-18, col. 7, lines 26-27), "transceiver" (134), "storage device" (102, col. 7, lines 9-11, col. 8, lines 12-13), "user playback control" (112, col. 1, lines 44-45, col. 8, lines 21-30), "digital decompressor" (112, col. 7, line 30), "playback device" (146), "user request interface" (140), "output converter" (120), "format converter"

(116). Walter's disclosure that "each memory device is identifiable by a respective address signal" (col. 2, lines 32-33) inherently teaches the "identification encoder" which "give items in said compressed data library a unique identification code."

Allowable Subject Matter

5. Claims 38-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 50-75 are allowed.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6743, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Application/Control Number: 09/120,452

Art Unit: 2734

Hand-delivered responses should be brought to Crystal Park II. 2121 Crystal Drive. Arlington VA. Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Le, whose telephone number is (703) 305-4769. The Examiner can normally be reached on Tuesday-Friday from 8:00 A.M. - 5:30 P.M. The examiner can also be reached on alternate Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703)305-4714.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

Amanda Le

January 19, 2000

Amanda T. Le
Primary Patent Examiner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OIPE JC68 MAR 23 2000 PATENT & TRADEMARK OFFICE

In re application of:	
YURT *et al.*	Art Unit: 2734
Appl. No. 09/120,452	Examiner: Le, A.
Filed: July 23, 1998	Atty. Docket: 03047.0006.US04
For: Audio and Video Transmission and Receiving System	

15 C 3-29-00

RECEIVED MAR 29 2000 TC 2700 MAIL ROOM

Reply and Amendment Under 37 C.F.R. § 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated January 24, 2000 (PTO Prosecution File Wrapper Paper No. 14), Applicants submit the following Remarks.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 08-3038.

Amendments

Please cancel claim 39 without prejudice to or disclaimer of the subject matter contained therein. Please amend claims 33 and 40 as follows.

1 ~~33~~. (Twice Amended) A communication system comprising:

a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises

a sequence encoder,

an identification encoder, and

a compressed data library in data communication with said identification encoder, wherein said identification encoder gives items in said compressed data library a unique identification code; and

wherein said reception system comprises

a transceiver in data communication with said transmission system,

a storage device in data communication with said transceiver,

user playback controls in data communication with said storage device,

a digital decompressor in data communication with said storage device, and

a playback device in data communication with said digital decompressor.

Claim 40, line 1, please delete "39" and substitute therefor --33--.

Remarks

Based on the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and they be withdrawn.

Upon entry of the foregoing amendment, claims 33-38 and 40-75 are currently pending in the application, with claims 33, 50 and 60 being the independent claims. The Examiner has indicated that claims 50-75 are allowed. The Examiner has also indicated that claims 38-40 would be allowable if rewritten in independent form or to otherwise include all of the limitations of the base claim and any intervening claims. Without conceding the propriety of the rejection, independent claim 33 has been amended herein to include the limitation of canceled claim 39, thereby placing independent claim 33 in allowable form. Claim 40 has been amended herein to depend from claim 33. All of rejected claims 34-37 and 41-49 depend directly or indirectly from allowable claim 33, rendering them allowable as well. Accordingly, Applicants respectfully submit that all of pending claims 33-38 and 40-75 are either allowed or in allowable form.

Rejection Under 35 U.S.C. § 102

The Examiner has rejected claims 33-37 and 41-49 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,506,387 to Walter ("the Walter patent"). Independent claim 33 has been amended herein, thereby rendering this rejection moot. The amendment herein places independent claim 33, and claims 34-37 and 41-49 depending directly or indirectly therefrom, in allowable form.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

Andrea G. Reister

Andrea G. Reister (Reg. No. 36,253)

Date: March 23, 2000

HOWREY SIMON ARNOLD & WHITE, LLP
Box No. 34
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2402
(202) 783-0800

Notice of Allowability

Application No.	Applicant(s)
09/120,452	Paul Yurt et al
Examiner	**Group Art Unit**
Amanda T. Le	2734

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to *the amendment filed on 03/23/00*.

☒ The allowed claim(s) is/are *33-38, 40-46, 48, 47, 49-72, 74, 73, 75 which are renumbered as 1-42 respectively*.

☒ The drawings filed on *Jul 23, 1998* are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) ______.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: ______.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☐ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☐ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. ______.

☐ including changes required by the proposed drawing correction filed on ______, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal lettter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *16*

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☐ Interview Summary, PTO-413

☐ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☐ Examiner's Statement of Reasons for Allowance

Amanda Le

AMANDA T. LE
PRIMARY EXAMINER
ART UNIT 2734